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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,760	03/21/2006	Yoshiyasu Fujiwara	0388-060452	3322

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EXAMINER
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NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2863

MAIL DATE	DELIVERY MODE
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03/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,760	<b>Applicant(s)</b> FUJIWARA, YOSHIYASU	
	<b>Examiner</b> MICHAEL P. NGHIEM	<b>Art Unit</b> 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 5-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-27-08, 6-15-07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-17 in the reply filed on February 10, 2009 is acknowledged. Group I is further restricted to Species I-XIII, and Applicant further elects Species I, claims 1-4. The traversal is on the ground(s) that "PCT Rule 13.2 provides that Rule 13.1 is fulfilled, that is, that an application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept, if inventions involve one or more of the same or corresponding special technical features. Group I and Group II require the same or corresponding special technical features because claims 1-17 of Group I and claims 18-29 of Group II require a trap operation diagnosis, a fluid leakage diagnosis and calculation of a trap-passed steam loss amount and a fluid leakage loss amount. Because of this same principle arrangement, claims 1-17 of Group I and claims 18-29 of Group II relate to a single general inventive concept under PCT Rule 13.1". Likewise, "Species I-XXV relate to a single general inventive concept under PCT Rule 13.1". This is not found persuasive because at least the calculation means of the method of Group I is distinct from the calculation means of the system of Group II. For example, Group I recites "...in the calculation of the trap-passed steam loss for all of the evaluation target steam traps based on the result of the trap operation diagnosis, this calculation is effected deductively, based on the result of the diagnosis for said

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plurality of steam traps and information relating to a ratio between the number of said plurality of stream traps and the total number of the evaluation target steam traps”

(claim 3). However, Group II recites “...calculating means for calculating, based on the result of the trap operation diagnosis inputted to the inputting means, a total trap-passed steam loss amount obtained by aggregating trap-passed steam loss amounts for all the evaluation target steam traps ...” (claim 18). Thus, the calculation of the trap-passed steam loss of Group I is distinct from that of Group II. PCT Rule 13.2 states that “the expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, as a whole, makes over the prior art.” Therefore, the claimed inventions of Group I and Group II, as a whole, lack the same or corresponding special technical feature. Likewise, at least the calculation means of Species I, claims 1-4, of Group I is distinct from the calculation means of the Species II, claims 5 and 17, of Group I. For example, Species I of Group I recites “...in the calculation of the trap-passed steam loss for all of the evaluation target steam traps based on the result of the trap operation diagnosis, this calculation is effected deductively, based on the result of the diagnosis for said plurality of steam traps and information relating to a ratio between the number of said plurality of stream traps and the total number of the evaluation target steam traps” (claim 3). However, Species II of Group I recites “... calculating, by said calculating means, a trap-passed steam loss amount obtained by aggregating trap-passed steam loss amounts for all the evaluation target steam traps and ... and generating, by said data generating means and based on the calculation results of said calculating means, comprehensive

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evaluation data having contents indicative of at least a total trap-passed steam loss amount and a total fluid leakage loss amount for each fluid type” (claim 5). Therefore, the claimed inventions of Species I and Species II, as a whole, lack the same or corresponding special technical feature.

Claims 5-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Group II and Species II-XIII of Group I, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

The information disclosure statement filed May 27, 2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The Korean reference 1999-13893 does not have an English Abstract or translation. Note US 6,145,529 and 6,728,659 are not US equivalents of the reference.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract contains more than one paragraph.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.

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- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Please add " BRIEF SUMMARY OF THE INVENTION" section and move the "BRIEF DESCRIPTION OF THE DRAWINGS" section to before the "BEST MODE OF EMBODYING THE INVENTION" or "DETAILED DESCRIPTION OF THE INVENTION" section.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that performing in a batch two or more kinds of diagnosis (trap operation diagnosis, fluid leakage diagnosis, system improvement diagnosis, and maintenance improvement diagnosis). However, the claim further requires all four of the diagnosis

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when reporting to the client. Thus, reporting results of all four of the diagnosis lack antecedent basis.

Claim 1, “the results of the plurality of kinds of diagnosis performed” (lines 12-13), “the result of the trap operation diagnosis” (line 14), “the result of the fluid leakage diagnosis” (line 19), ), “the result of the system improvement diagnosis” (line 24), and “the result of the maintenance improvement diagnosis” (line 28) lack antecedent basis.

Claim 1, “the maintenance system” (line 30) lacks antecedent basis.

Claim 1, “needing improvement” (lines 26, 30) is redundant.

Claim 3, “the calculation of the trap-passed steam loss” (line 5) lacks antecedent basis.

The remaining claims are also rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a rejected base claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.



The method is not tied to another statutory class (such as a particular apparatus) or transforms an underlying subject matter (such as an article or material). Thus, the method is not a patent eligible process under 35 USC 101 and is directed to non-statutory subject matter. See *In re Bilski*, Appeal No. 2007-1130.

To qualify as a 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Note in claim 1, the steps of replacing or repairing (e.g. lines 16, 21) do not require a machine or apparatus to perform the steps.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fujiwara (US 7,130,804) discloses a system for supporting sales and maintenance activities of steam traps by a seller of the traps to customer (Abstract, lines 1-2).

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Shukunami et al. (US 6,332,112) discloses a method and system for inspecting and managing steam traps (Title, Abstract).

However, neither reference discloses a system improvement diagnosis.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael P. Nghiem/

Primary Examiner, GAU 2863

March 16, 2009